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**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Patent Cooperation Treaty Legal Office

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In re Application of  
Robert John Mabbott  
Application No.: 08/716,360  
PCT No.: PCT/GB95/00601  
Int. Filing Date: 17 March 1995  
Priority Date: 18 March 1994  
Attorney Docket No.: 16286-702  
For: TRANSFER MATERIALS

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: DECISION ON PETITIONS  
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This is a decision on applicant's renewed petition under 37 CFR 1.47(b) filed in the Patent and Trademark Office (PTO) on 13 July 1998. No additional petition fee is required.

**BACKGROUND**

On 21 March 1997, applicant filed a petition under 37 CFR 1.47(b) requesting acceptance of the application without the signature of the inventor on the grounds that Mr. Mabbott cannot be reached or located after diligent efforts. The petition was dismissed in a decision dated 13 January 1998 because (1) applicant failed to provide sufficient evidence that Mr. Mabbott cannot be found after diligent efforts and (2) the declaration filed therewith was insufficient in that the title of the person signing was not indicated thereon. Specifically, regarding item (1), the declaration of Alan Brian Porter submitted therewith generally discussed several efforts to reach Mr. Mabbott, but was not accompanied by any detailed accounts or documentation of such efforts.

On 13 July 1998, applicant filed a petition for a four-month extension of time and a renewed petition under 37 CFR 1.47(b) in which, with regard to item (2) above, counsel indicated that the title of the person who signed the combined declaration and power of attorney submitted 21 March 1997 is "Director of ISO Development, Ltd. The renewed petition was not accompanied by a substitute declaration indicating the title of the person

signing. As to item (1), petitioner submitted a declaration of Roger Bruce Thomson stating that he made a personal visit to Mr. Mabbott's last known address and confirmed that he was no longer there and that he was unknown to the current occupants. The Thomson declaration further stated that he checked in the local phone directories for any entry under RJ Mabbott, but again without finding any entry.

The \$755 fee for a four-month extension of time has been charged to **Deposit Account No. 23-2415**, as authorized in the petition for extension of time filed 13 July 1998.

### DISCUSSION

Regarding item (2) above, petitioner has apparently misunderstood the requirement in the decision dated 13 January 1998. As set forth in MPEP 409.03(b), the declaration under 37 CFR 1.63 must indicate the title of the person signing on behalf of a corporation. Petitioner is required to provide a substitute declaration under 37 CFR 1.63 indicating the title of the person signing.

Regarding item (1) above, petitioner has still not provided sufficient proof that the inventor refuses to execute the application or cannot be reached after diligent effort. As discussed in the decision dated 13 January 1998, where inability to find or reach a non-signing applicant, after diligent effort, is being alleged an affidavit or declaration of facts should be submitted which fully describes the exact facts which are being relied upon to establish that a diligent effort was made. The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of any documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., which support a finding that the non-signing inventor could not be found or reached should be made a part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

With the petition filed 21 March 1997, petitioner provided a declaration of Alan Bryan Porter which stated that efforts made to find Mr. Mabbott had been unsuccessful. However, in spite of the request for details and documentation regarding these efforts set forth in the decision dated 13 January 1998, petitioner has not provided such statements and other documentation. Copies of any letters and facsimile communications still have not been provided. Statements from person(s) having firsthand knowledge of the efforts made to locate Mr. Mabbott, including the private investigator employed, should be furnished detailing the efforts made. Copies of any documentary evidence should be provided. Was a copy of the application comprising the specification, including the claims, drawings and declaration/oath therefore mailed or otherwise attempted to be presented to the non-signing inventor. Is correspondence mailed to Mr. Mabbott at his last known address returned as undeliverable? If

so, such should be documented. The details surrounding the efforts made to contact Mr. Mabbott including a copy of any correspondence mailed and the dates and times of any attempted telephone contacts should be provided via statements of person(s) having firsthand knowledge thereof. Examples of evidence to be submitted, if available, include copies of any documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., which support a finding that the non-signing inventor could not be found or reached. Furthermore, statement(s) regarding any telephone conversations from the person(s) having firsthand knowledge should be provided including the date and time thereof to the extent such conversations, if any, relate to either the inability to locate Mr. Mabbott, or the refusal of Mr. Mabbott to sign the oath/declaration for this application. For example, the declaration of Mr. Porter states that contact was made with Mr. Mabbott's parents and sisters, but does not provide details, such as the date(s), time(s) and place(s) or mode(s) of such contact. The specific efforts made, including the method(s) used, in attempting to present the application to Mr. Mabbott for execution should be presented in detail in any statements presented. Copies of any documentary evidence associated with such attempts are required. The copy of the statements regarding the efforts to secure the signature of Mr. Mabbott for another application are not sufficient for proving the unavailability of Mr. Mabbott to sign the present application.

The declaration of Roger Bruce Thomson filed 13 July 1998 states that he made a personal visit to Mr. Mabbott's last known address and confirmed that he no longer was there and that he was unknown to the current occupants, but does not indicate the date on which such visit was made. The declaration further states that local telephone directories were consulted. However, petitioner still has not indicated whether an attempt was made to mail a copy of the application papers (specification, including claims, drawings and declaration) to Mr. Mabbott at the last known address to determine whether such mail is undeliverable or whether such mail can be forwarded to Mr. Mabbott. Copies of documentary evidence such as certified mail receipts, cover letter of instructions, telegrams, etc. should be provided as evidence of such attempts. Further, has an attempt been made to contact the local mail delivery service(s) to see if Mr. Mabbott left a forwarding address with them? Further, details and documentation of the efforts set forth in Mr. Porter's declaration, including receipts and reports from the private investigator, statements regarding any telephone conversations, certified mail receipts, cover letters of instruction, telegrams, etc., should be provided or their unavailability explained.

In view of the above, item (1) has clearly not been satisfied.

Accordingly, it is inappropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

**CONCLUSION**

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition under 37 CFR 1.47(b) is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.



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